APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,604	01/25/2001	Stephen M. Howard	EMC-002PUS	4397

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EXAMINER
OSMAN, RAMY M

ART UNIT	PAPER NUMBER
2157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/769,604	HOWARD ET AL.
	Examiner	Art Unit	
	Ramy M. Osman	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 July 2007</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15 and 17-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 17-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This communication is in response to amendments filed on July 24, 2007, where

applicant added new claim 22. Claims 1-15,17-22 are pending.

Response to Amendment

2.   Applicant's arguments filed 7/24/2007 have been fully considered but as a whole they are

not persuasive.

3.   The Declaration filed on June 6, 2007 under 37 CFR 1.131 continues to be deemed

ineffective to overcome the Davis reference (US Patent Application No 6,594,677).

4.   Applicant argues that they are attempting to establish "actual reduction to practice" and

not "constructive reduction to practice" and therefore the Declaration is not required to contain a

disclosure of "how to use" and "how to make" the invention, as mentioned in MPEP 2138.05

section I.

        In reply, Applicant is correct in that MPEP 2138.05 section I applies to constructive

reduction to practice. However, Applicant has not demonstrated with evidence that the

Declaration satisfies some of the other requirements as outlined in sections II to IV of MPEP

2138.05. (See Response to Declaration below)

5.   Applicant argues that the Declaration meets the requirements of Rule 1.131.

        In reply, Applicants arguments are mere assertions and do not give enough detail to meet

the requirements of 1.131. (See Response to Declaration below)

Response to Declaration Under 37 CFR 1.131

REDUCTION TO PRACTICE

6.   Applicant is attempting to establish actual reduction to practice of the claimed invention

prior to December 22, 2000.

MPEP states:

> While conception is the mental part of the inventive act, it must be capable of proof, such as
> by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague
> idea of how to solve a problem. The requisite means themselves and their interaction must also be
> comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). **(see
> MPEP 715.07)**
> A general allegation that the invention was completed prior to the date of the reference is not
> sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a
> declaration by the inventor to the effect that his or her invention was conceived or reduced to practice
> prior to the reference date, without a statement of facts demonstrating the correctness of this
> conclusion, is insufficient to satisfy 37 CFR 1.131. **(see MPEP 715.07, section I)**
> The affidavit or declaration and exhibits must clearly explain which facts or data applicant is
> relying on to show completion of his or her invention prior to the particular date. Vague and general
> statements in broad terms about what the exhibits describe along with a general assertion that the
> exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof
> or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re
> Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the
> exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19,
> 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts
> that facts exist but does not tell what they are or when they occurred."). **(see MPEP 715.07, section
> III)**
> The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be
> done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in
> the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be
> specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. **(see
> MPEP 715.07, section III)**

7.   To begin with, the submitted Declaration of the inventors is not deemed acceptable to

establish conception of the invention prior to the date of the reference. Proof of conception is

acceptable if it is in the form a disclosure of the invention to another person, where the disclosure

includes the means of the invention and the interaction of those means (see MPEP 715.07 section

III).

It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence. **(MPEP 2138.04)**

Exhibit A only shows an e-mail that discusses the software release. However, no evidence has been presented that demonstrates that the software release indeed performs the means of the invention. The e-mail neither contains a discussion regarding the functionality of the software release nor contains a discussion regarding elements of the claimed invention.

8.   More importantly, Applicant has not shown reduction to practice since Applicant has not demonstrated sufficient evidence to show that the invention existed in a physical or tangible form that shows every element of the claimed invention. As stated above, the submitted Declaration is not even deemed sufficient to prove conception of the invention.

In order to demonstrate actual reduction to practice, Applicant is required to show that the invention actually existed and worked for its intended purpose (see MPEP 715.07). Applicant is required to show that the invention existed in a physical or tangible form that shows every element of the invention (see MPEP 2138.05 section II). Benchmark or laboratory testing may be further required to show that the invention worked for its intended purpose (see MPEP 2138.05 section III).

Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established by what exhibit, and what facts are relied upon by applicant. General statements and assertions by the Applicant that the exhibits describe a reduction to practice "amounts to mere pleading, unsupported by proof or a showing of facts" (see MPEP 715.07 section I).

The Declaration lacks a detailed mapping explaining how the claim limitations correspond to the exhibits and evidences provided.

Exhibit B shows a listing of source file names. There is no demonstration as to the functionality of the source file names. There is no explanation as to how these source file names relate to the claim limitations.

Exhibit C is a listing of source files that comprise the executable file edmrestoreengpd. Reduction to practice has not been shown because there is no evidence that this executable file actually performs each of the claim limitations of the instant application.

Exhibit D shows a source code listing for a module of the invention. There is no explanation as to which part(s) of the source file performs each of the claim limitations. Therefore, Reduction to Practice has not been shown.

9.   Each of the claim limitations found in the instant application have not been shown or explained in light of the exhibits so as to provide enough evidence of reduction to practice.

Thus, applicant has not met the burden of showing how the exhibit supports conception and reduction to practice of the claimed invention and has not established that reduction to practice occurred prior to the date of the Davis reference.

DILIGENCE

10.   Since Applicant has not demonstrated an actual reduction to practice, then Applicant may attempt to antedate the Davis reference by demonstrating conception of the invention prior to the date of the reference coupled with due diligence from prior to the reference date until the filing date of the instant application. Applicant would be required to demonstrate reasonable diligence during the critical period which begins prior to the date of the reference and ends with either the filing of the US application or with a demonstrated actual reduction to practice (see MPEP

715.07 (a)). The entire critical period must be accounted for by either affirmative acts or

acceptable excuses.

Claim Objections

11.   Claim 22 objected to because of the following informalities: The claim does not end with

a period. On the last line of the claim, change ";" to ".". Appropriate correction is required.

Claim Rejections - 35 USC § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13.   Claims 1-15,17-22 rejected under 35 U.S.C. 102(e) as being anticipated by Davis et

al (US Patent No 6,594,677).

14.   In reference to claim 1, Davis teaches a method of restoring backed up data, comprising:

retrieving, by a data backup and storage system, a list of objects that are restorable by a

client having a backup/restore module and a logical volume manager to communicate with a

storage system, the backup storage system having a storage system interface to communicate

with the storage system, a backup storage unit to store backed up data, and a network interface to

communicate with the client (column 6 lines 20-50);

displaying the list of restorable objects for browsing by a user, wherein the restorable

objects are located on a plurality of physical storage devices (column 3 lines 1-15);

generating a first list of restorable objects marked for restoration by the user, wherein

each of the restorable objects is associated with a particular library, wherein the library supports

at least one catalog containing information for the backed up data including media type and

metadata (column 5 lines 40-57);

submitting the first list of marked restorable objects to the backup storage system for

restoration for the client (column 3 lines 1-15);

submitting a second list of marked restorable objects to the backup storage system

(column 3 lines 1-15);

executing, by the backup storage system, a restoration of the submitted first and second

lists of marked restorable objects via a remote procedure call such that first and second restore

submissions can be made prior to restore execution (column 5 line 52 – column 6 line 8).

15.   In reference to claim 2, Davis teaches the method according to claim 1, further including

executing the first and second lists of marked restorable objects concurrently (column 5 lines 62-

67).

16.   In reference to claim 3, Davis teaches the method according to claim 1, further including

initiating a restore session for the client. (column 3 line 50 – column 4 line 10).

17.   In reference to claim 4, Davis teaches the method according to claim 3, further including

creating a restore engine process for the retrieving, browsing, submitting and executing of restore

objects (column 5 lines 10-60).

18.   In reference to claim 5, Davis in view of Rodriguez teaches the method according to claim 4, wherein the client communicates with the restore engine process via remote procedure calls (column 3 line 50 – column 4 line 10).

19.   In reference to claim 6, Davis in view of Rodriguez teaches the method according to claim 4, wherein the restore engine process is created by a dispatch daemon on a backup storage system server. (column 7 line 55 – column 8 line 20).

20.   In reference to claim 7, Davis teaches the method according to claim 4, wherein the restore engine process is terminated upon completion of the restore execution (column 7 line 55 – column 8 line 20).

21.   In reference to claim 8, Davis in view of Rodriguez teaches the method according to claim 4, wherein the restore engine process runs on a backup data storage server and further including creating a work item restore process on the backup data server, a server restore process for generating a stream of data to be restored, and a client restore process for receiving the data stream. (column 7 line 55 – column 8 line 20).

22.   In reference to claim 9, Davis teaches the method according to claim 4, further including detecting and identifying libraries that support associated catalogs of backed up data for processing of backed up data by the restore engine process. (column 5 lines 40-57)

23.   In reference to claim 10, Davis teaches the method according to claim 9, further including adding a new library supporting new methods of backing up data (column 5 lines 40-57).

24.   In reference to claim 11, Davis teaches the method according to claim 9, further including determining object types for backed up data supported by the libraries (column 5 lines 40-57).

25.   In reference to claims 12,13 and 15, Davis teaches a method of restoring backed up data

and a corresponding system, comprising:

        initiating a restore session for a first client through a graphical user interface associated

with the client (column 3 line 50 – column 4 line 10);

        establishing a connection between the graphical user interface and the restore engine

process (column 3 line 50 – column 4 line 10);

        displaying a list of restorable objects for browsing by a user associated with the client via

the graphical user interface under the control of the restore engine process (column 3 lines 1-15);

        identifying restorable objects marked for restoration by the user under control of the

restore engine process (column 3 lines 1-15);

        storing first and second lists of marked restorable objects submitted by the client to the

restore engine process (column 3 lines 1-15); and

        executing the restoration of the first and second lists of marked objects under control of

the restore engine process independently of the browsing, marking and submitting of the

restorable object such that multiple restore submissions can be made prior to restore execution

(column 5 line 52 – column 6 line 8).

26.   In reference to claim 14, Davis teaches the method according to claim 12, further

including supporting a new backup data method by adding a library corresponding to the new

backup data method. (column 5 lines 40-57)

27.   In reference to claims 17, Davis teaches the system according to claim 15, wherein the

restore engine process processes library's upon restore initialization such that libraries can be

added to the system for supporting new backup methods. (column 5 lines 40-57)

28.   In reference to claims 18, Davis teaches the system according to claim 17, further

including a dispatch daemon for initiating the restore session (column 7 line 55 – column 8 line

20).

29.   In reference to claims 19, Davis teaches the system according to claim 15, further

including further restore engine processes corresponding to further restore sessions initiated by

additional clients (column 7 line 55 – column 8 line 20).

30.   In reference to claims 20, Davis teaches the system according to claim 19, further

including additional restore triangles for executing multiple work item restores concurrently

(column 5 lines 62-67).

31.   In reference to claims 21, Davis teaches the system according to claim 15, wherein each

of the restorable objects is associated with a particular library (column 5 lines 40-57).

32.   In reference to new claim 22, Davis teaches a method of restoring backed up data,

comprising:

        retrieving, by a data backup and storage system, a list of objects that are restorable by a

client having a backup/restore module and a logical volume manager to communicate with a

storage system, the backup storage system having a storage system interface to communicate

with the storage system, a backup storage unit to store backed up data, and a network interface to

communicate with the client (column 6 lines 20-50);

        displaying the list of restorable objects for browsing by a user, wherein the restorable

objects are located on a plurality of physical storage devices (column 3 lines 1-15);

        generating a first list of restorable objects marked for restoration by the user, wherein

each of the restorable objects is associated with a particular library, wherein the library supports

at least one catalog containing information for the backed up data including media type and

metadata (column 5 lines 40-57);

submitting the first list of marked restorable objects to the backup storage system for

restoration for the client (column 3 lines 1-15);

submitting a second list of marked restorable objects to the backup storage system

(column 3 lines 1-15);

executing, by the backup storage system, a restoration of the submitted first and second

lists of marked restorable objects via a remote procedure call such that first and second restore

submissions can be made prior to restore execution (column 5 line 52 – column 6 line 8)

wherein the objects in the list of objects includes encapsulated information to initialize,

execute, and cleanup the restore execution (column 5 lines 1-6,12-23 & 40-43).
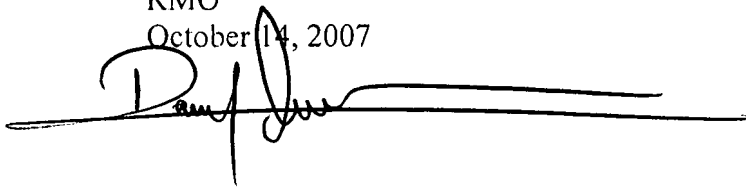

Conclusion

33:     Applicant is advised that the above specified citations of the relied upon prior art are only

representative of the teachings of the prior art, and that any other supportive sections within the

entirety of the reference(s) (including any figures, incorporation by references, and claims) is

implied as being applied to teach the scope of the claims.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008.

The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO
October 14, 2007